

SN



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,437	12/29/2000	Warren T. Dent	MSI-423USC1	8758

22801 7590 12/19/2003

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE, WA 99201

EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,437

Applicant(s)

DENT ET AL.

Examiner

Harish T Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30,33-49,52,53 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30,33-49,52,53 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3628

DETAILED ACTION

Note: Claims 31, 32, 50, 51, and 54 are canceled.

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "comprising" should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claims 26 & 49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 26 and 49 claim storage medium excluding certain features of the claimed structure explained in the based claims (claim 1 and 27), for example: a plurality of computing devices, data serve, etc.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim s 1-4, 6-8, 12-14, 26-30, 33-38, 49 & 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Starr (US 6,606,606).

Re. Claim 1, Starr discloses plurality of computing devices, coupled to the network, to facilitate network access by one or more participants, and a data server, coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including [see entire document particularly, [see entire document particularly, Abstract; Figures 1-2; C1 L15 to C3 L31; C4 L7-57], and a storage medium to store at least one financial account for each of the plurality of participants, and a financial transaction manager, coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant, wherein the financial transaction manager is also to issue an instruction to have a check issued that includes an offer to receive future funds via an electronic financial account, wherein the financial transaction manager is also to issue an instruction to have a check issued

Art Unit: 3628

that includes an offer to receive future funds via an electronic financial account [C5 L57 to C6 L11].

Re. Claims 2-4, and 6-7 Starr discloses wherein the financial account is electronically linked to an account of the participant at a financial institution, and wherein the account of the participant is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution, or a services account associated with another commercial enterprise, and wherein the financial account is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution, and further comprising a financial service center having a plurality of data servers including the data server, and wherein the data server is controlled by a financial institution [C1 L15 to C3 L31; C5 L57 to C7 L4].

Re. Claim 8, Starr discloses wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets [C1 L15 to C3 L5].

Re. Claims 12-14 Starr discloses wherein the financial transaction manager selectively receives assets for deposit in an account of a participant, and wherein the assets are received from a brokerage at the request of the participant, and wherein the assets are received from an employer as compensation to the participant [C1 L15 to C3 L31; C6 L12-L52].

Re. Claim 26, Starr discloses storage medium having stored thereon a plurality of executable instructions [Fig. 5-6; C6 L1-L11; C7 L5-L20]

Re. Claim 27, Starr discloses a user interface, through which a user accesses an account associated with the user, one or more storage devices, to store and maintain account information for each of the users, and a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the financial service center, wherein the financial transaction manager causes a check to be printed and sent to another at the request of a user, and wherein the check includes an offer to receive future funds via an electronic account at the financial service center [Abs; Fig1-2; C1 L15 to C3 L31; C4 L7-57; C5 L57 to C6 L11].

Re. Claims 28-30 & 33-35, Starr discloses a user interface web page (wherein the user interface is series of instructions issued to a computing device of the user to create a web page at the computing device) [C4 L25-L48], an email (wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant) [C8 L37 to C9 L19], and wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in

Art Unit: 3628

response to a request by the first user to transfer such assets [C1 L15 to C3 L5], and wherein each of the first and second users are individual consumers, and wherein the first user does not have a priori knowledge of the second user's account information, but identifies the second participant from a list of network participants provided by the financial transaction manager, and wherein the second user is identified by one or more of the user's name, alias, or email address [Fig. 3-4; C1 L15 to C3 L5; C7 L5-L20; C8 L37 to C9 L19].

Re. Claims 36-38 Starr discloses wherein the financial transaction manager selectively receives assets for deposit in an account of a participant, and wherein the assets are received from a brokerage at the request of the participant, and wherein the assets are received from an employer as compensation to the participant [C1 L15 to C3 L31; C6 L12-L52].

Re. Claim 49, Starr discloses storage medium having stored thereon a plurality of executable instructions [Fig. 5-6; C6 L1-L11; C7 L5-L20].

Re. Claim 55, Starr discloses a storage device having stored thereon a plurality of executable instructions, and a processor, coupled to the storage device, to execute the instructions and implement a financial transaction manager, wherein the financial transaction manager enables a user to conduct financial transactions with a number of people, wherein each of the checks includes an offer to receive future funds via an

electronic financial account [Abs; Fig1-2; C1 L15 to C3 L31; C4 L7-57; C5 L57 to C6 L11].

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Starr.

Re. Claim 5, Starr discloses enabling the customer to access to financial account using PC [C4 L57 to C5 L57]. Starr, explicitly, does not disclose access financial account using a kiosk, a telephone and a set-top box. However, a kiosk, a telephone and a set-top box, ATM are well known devices to one skill in the art which are used to connect to the financial institution accounts.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starr in view of Schrader et al (hereinafter Schrader – US 5,903,881)

Re. Claims 9-11 Starr, explicitly, does not disclose wherein each of the first and second participants are individual consumers, and wherein the first participant does not have a

Art Unit: 3628

priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants, and wherein the second participant is identified by one or more of a name, an alias, a physical address, a virtual address, or an email address. However, Schrader discloses these steps [see entire document particularly, Abs; Fig. 3-11; C1 L5 to C7 L14]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosure of Starr and Schrader to provide customer (individual user) an online banking system to manage its account.

Claims 15-22, 39-45, and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starr in view of O'Leary et al (hereinafter O'Leary – US 6,609,113).

Re. Claim 15-17 Starr, explicitly, does not disclose wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service, and wherein the network service is an electronic auction service, and wherein the network service is an electronic retail service. However, O'Leary discloses these steps [C15 L45 to C16 L55; C20 L44 to C21 L44]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to disclosures of Starr and O'Leary to allow user to purchase items or a service through an electronic auction or other convenient e-commerce locations (retail service).

Art Unit: 3628

Re. Claims 18-22, Starr, explicitly, does not disclose wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant, and wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment. However, O'Leary discloses these steps [C16 L17 to C17 L32]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr and O'Leary to verify the user's balance in the primary account is sufficient to make payments or make overdraft or use line-of-credit.

Re. Claims 39-41 Starr, explicitly, does not discloses wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service, and wherein the network service is an electronic auction service, and wherein the network service is an electronic retail

Art Unit: 3628

service. However, O'Leary discloses these steps [O'Leary et al C15 L45 to C16 L55; C20 L44 to C21 L44]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to disclosures of Starr and O'Leary to allow user to purchase items or a service through an electronic auction or other convenient e-commerce locations (retail service).

Re. Claims 42-45 Starr, explicitly, does not discloses wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant, and wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment, and wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment, and wherein' the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment However, O'Leary discloses these steps [C16 L17 to C17 L32;]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr and O'Leary to verify the user's balance in the primary account is sufficient to make payments or make overdraft or use line-of-credit.

Art Unit: 3628

Re. Claims 52-53 Starr, explicitly, does not disclose receiving a request to issue a check to a recipient from a consumer, including on the check an offer to receive future funds via an electronic financial account with a pre-printed unique access code for the account (PIN), and receiving a request to perform a financial transaction at a data server within a financial data network from a requesting participant, and issuing a physical check drawn from an account on the financial data network associated from an account of the network participant to the transaction recipient, wherein the check includes an offer (coupon) to utilize an account created within the electronic financial network and associated with the requesting participant to receive future funds.

However, O'Leary discloses these steps [see entire document particularly, Abs; Figures 1-10; C1 L22 to C8 L5]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to disclosures of Starr and O'Leary to enable user of internet to have immediate access to financial institution account and make low cost payments.

Claims 23-25 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starr and O'Leary in view of Schrader.

Re. Claims 23-25, Neither Starr nor O'Leary, explicitly, discloses wherein the instruction is an instruction to have the check issued and sent to an address specified by the request, upon authorization of the participant, wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where

Art Unit: 3628

the recipient can establish an account, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Schrader discloses these steps [Fig. 3-11; C1 L5 to C7 L14]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr, O'Leary and Schrader to allow the customer make a payment online using the web page URL provided to reduce cost on payment transaction.

Re. Claims 46-48, Neither Starr nor O'Leary, explicitly, discloses wherein the instruction is an instruction to have the check issued and sent to an address specified by the request, upon authorization of the participant, and wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account, and wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Schrader discloses these steps [Fig. 3-11; C1 L5 to C7 L14]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Starr, O'Leary and Schrader to allow the customer make a payment online using the web page URL provided to reduce cost on payment transaction.

Conclusion

Art Unit: 3628

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US Pat. 6,173,272 to Thomas et al, Jan. 9, 2001 «Electronic funds transfer method and system and bill presentment method and system», discloses a funds transfer system for facilitating electronic funds transfer between a payor and a payee by means of an intermediate trusted third party comprises a payor station including a device for electronic communication of a payment order, the payment order comprising the payee's name, address and an amount owed by the payor to the payee; a home banking system including a computer structured to communicate electronically at least with the payor station, to receive the payment order, and with the trusted third party; a trusted third party system associated with the trusted third party, the trusted third party system comprising a computer structured to communicate electronically with both the home banking system and a bank of the payee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3628

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Harish T Dass HTD

Examiner

Art Unit 3628

12/3/03


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600